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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212931
Party	Defendant Gregg Donnenfeld
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	01/23/2014
Attachments	First Amended Answer to Notice of Opposition.pdf(187626 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:
Application Serial No. 85/877,499
Mark: EGG WHITE DELIGHT
Publication Date: October 1, 2013

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MCDONALD'S CORPORATION,	:	
	:	
Opposer,	:	Opposition No. 91212931
	:	
v.	:	
	:	
GREGG DONNENFELD,	:	
	:	
Applicant.	:	
-----X		

FIRST AMENDED ANSWER TO NOTICE OF OPPOSITION

Applicant Gregg Donnenfeld ("Applicant") respectfully submits this First Amended Answer to the Notice of Opposition (the "Opposition") filed by McDonald's Corporation ("Opposer") in connection with the above-referenced application.¹

1. Applicant admits the allegations in paragraph 1 of the Opposition.
2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 2 of the Opposition, and therefore denies them.
3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 3 of the Opposition, and therefore denies them.
4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in the first two sentences of paragraph 4 of the Opposition, and therefore

¹ This First Amended Answer is filed with express prior authorization from the Trademark Trial and Appeal Board, and is identical to the Answer earlier filed, except (a) restates the fourth affirmative defense set forth in paragraph 17 below, and (b) eliminates a previously asserted fifth affirmative defense.

denies them. Applicant denies the allegations in the third sentence of paragraph 4 of the Opposition. Applicant additionally states that, if and to the extent that Opposer there alleges that “the public has come to associate the phrase ‘EGG WHITE DELIGHT’ with Opposer’s EGG WHITE DELIGHT McMUFFIN breakfast sandwich”, such association occurred following the date of Applicant’s trademark filing.

5. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 5 of the Opposition, and therefore denies them. Applicant additionally states that none of the facts or circumstances alleged by Opposer in such paragraph constitute common law trademark use necessary or sufficient to prevent Applicant’s EGG WHITE DELIGHT mark from maturing to registration based upon Applicant’s earlier-filed intent-to-use trademark application.

6. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 6 of the Opposition, and therefore denies them. Applicant additionally states that none of the facts or circumstances alleged by Opposer in such paragraph constitute common law trademark use necessary or sufficient to prevent Applicant’s EGG WHITE DELIGHT mark from maturing to registration based upon Applicant’s earlier-filed intent-to-use trademark application.

7. Applicant admits the allegations in the first sentence of paragraph 7 of the Opposition. Applicant denies the allegations in the second and third sentences of paragraph 7 of the Opposition.

8. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 8 of the Opposition, and therefore denies them. Applicant further states that Opposer alleges Applicant to be “an experienced trademark attorney”, and in

Applicant's "experienced" opinion, the Opposition is without merit and should be dismissed with prejudice.

9. Applicant denies the allegations in paragraph 9 of the Opposition.
10. Applicant denies the allegations in paragraph 10 of the Opposition.
11. Applicant denies the allegations in paragraph 11 of the Opposition.
12. Applicant denies the allegations in paragraph 12 of the Opposition.
13. Applicant denies the allegations in paragraph 13 of the Opposition.

AFFIRMATIVE DEFENSES

14. Applicant has priority of rights with respect to the EGG WHITE DELIGHT mark by virtue of Applicant having filed an intent-to-use trademark application prior to the date that Opposer made any trademark filing for the mark.

15. Applicant has priority of rights with respect to the EGG WHITE DELIGHT mark by virtue of Applicant having filed an intent-to-use trademark application prior to the date that Opposer made common law trademark use necessary or sufficient to prevent Applicant's EGG WHITE DELIGHT mark from maturing to registration based upon Applicant's earlier-filed intent-to-use trademark application.

16. Opposer's status as a corporation with market capitalization in excess of \$96 Billion Dollars does not render Opposer exempt from the rules and laws that apply to the general public; and does not permit or entitle Opposer to acquire national trademark rights in the absence of use based upon a press release as an alternative to a trademark application.


17. In the alternative, if and to the extent that Opposer made any common law trademark use of the EGG WHITE DELIGHT mark prior to the date that Applicant filed his intent-to-use trademark application, then Opposer cannot rely on such prior common law use as a

means of establishing priority of rights over Applicant's filing because Opposer abandoned those rights by having ceased such use without intent to resume use of the trademark in the future (and any new use thereafter made by Opposer would have occurred only after the date of Applicant's trademark filing). Opposer admits having ceased use of the mark prior to Applicant's filing, and Opposer's failure to have filed a U.S. trademark application covering the mark at any time prior to the date of Applicant's filing evidences that Opposer lacked the intent to resume such use at all relevant times.

WHEREFORE, Applicant respectfully submits that the Opposition should be dismissed with prejudice, and that Applicant's mark be granted registration.

Dated: January 23, 2014

Respectfully submitted,



Applicant Gregg Donnenfeld
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Certificate of Service

I hereby certify that on January 23, 2014, a true and correct copy of the foregoing First Amended Answer to Notice of Opposition was served by United States first class mail, postage prepaid, on counsel for Opposer at the following address:

Michael G. Kelber, Esq.
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Gregg Donnenfeld